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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/063,988

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David Carroll Challener

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EXAMINER

ABYANEH, ALI S

ART UNIT

PAPER NUMBER

2137

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/063,988

Applicant(s)

CHALLENGER ET AL.

Examiner

Ali S. Abyaneh

Art Unit

2137

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 02 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-14 are pending.
2. Examiner withdraws objection to the claims 1-14 due to correction by applicant.

### ***Response to Arguments***

3. Applicant's arguments filed 03-02-2006 have been fully considered but they are not persuasive.

Applicant contends, " both Chen et al and Gray teach that the second input device is never connected between what the examiner deems equivalent to the first input device and the security device". However Examiner respectfully disagrees. Chen teaches a first input device (keyboard 14), and a security element (trusted device 24), which they are connected through the input/output device 23 and data bus 26 (see paragraph [0034]). Although Chen teaches other input devices connected to the security element he does not explicitly teach a second input device selectively interposed between the first input device and the security element. However, in an analogous art Gray teaches a second input device (verification unit 20) selectively interposed between the first input device and the security element (see column 4, lines 43-49).

In response to Applicant argument that "there is no teaching of selective interposition", Gary clearly teaches selective interposition (see column 5, lines 53-65).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

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where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify chen invention to include a second input device selectively interposed between the first input device and the security element. This modification would have been obvious because person having ordinary skill in the art would have been motivated to do so in order to enforce access control to one or more application programs running on the computer and furthermore to verify data entered through a keyboard with the data stored on a token such as a card, while isolating the entered data from the computer (column 2, lines 50-52).

**Declaration Under 37 CFR 1.31: ineffective**

6. The declaration filed on 03-02-06 under 37 CFR 1.131 has been considered but is ineffective to overcome the Chen reference (US Publication No 2003/0046542).

a. Based on the evidence supplied, it appears that applicant is relying on conception prior to the effective date of the reference, followed by diligence until the US filing date.

**Formal Requirements of Affidavits and Declarations (MPEP715.04 [R-2])**

The following parties may make an affidavit or declaration under 37 CFR 1.131:

- (A) All the inventors of the subject matter claimed.
- (B) An affidavit or declaration by less than all named inventors of an application is accepted where it is shown that less than all named inventors of an application invented the subject matter of the claim or claims under rejection. For example, one of two joint inventors is accepted where it is shown that one of the joint inventors is the sole inventor of the claim or claims under rejection.
- (C) If a petition under 37 CFR 1.47 was granted or the application was accepted under 37 CFR 1.42 or 1.43, the affidavit or declaration may be signed by the 37 CFR 1.47 applicant or the legal representative, where appropriate.
- (D) The assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. *Ex parte Foster*, 1903 C.D. 213, 105 O.G. 261 (Comm'r Pat. 1903). Affidavits or declarations to overcome a rejection of a claim or claims must be made by the inventor or inventors of the subject matter of the rejected claim(s), a party qualified under 37 CFR 1.42, 1.43, or 1.47, or the assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor(s). Thus, where all of the named inventors of a pending application are not inventors of every claim of the application, any affidavit under 37 CFR 1.131 could be signed by only the inventor(s) of the subject matter of the rejected claims. Further, where it is shown that a joint inventor is deceased, refuses to sign, or is otherwise unavailable, the signatures of the remaining joint inventors are sufficient. However, the affidavit or declaration, even though signed by fewer than all the joint inventors, must show completion of the invention by all of the joint inventors of the subject matter of the claim(s) under rejection. *In re Carlson*, 79 F.2d 900, 27 USPQ 400 (CCPA 1935).

- b. The declaration is not signed by the inventor James P. Ward and does not comply with the formal requirements set forth.

**Insufficient evidence of Conception Before References Date**

- c. In page 13, paragraph 1, applicants allege that "This declaration is to establish completion of the invention in this application in the United States, at a date prior September 4, 2001, the effective date of the Chen et al U.S. Published Patent application 2003/0046542 cited by the examiner". However, The evidence

submitted is insufficient to establish a conception of the invention prior to the effective date of the Chen reference.

While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show. Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by Applicant (see MPEP 715.07).

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.").

**Insufficient evidence of Diligence Before References Date**

d. Per MPEP 715.07(a)

In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. Ex parte Kantor, 177 USPQ 455 (Bd. App. 1958).

However for purpose of prosecution, the examiner notes that the evidence submitted by applicant is insufficient to establish diligence from a date prior to the effective date of the Chen reference (Sep 4, 2001) to the US filing date of this application (May 31, 2002). Applicant merely stated that applicant has been diligent from prior to Sep 4, 2001 to May 31, 2002, without providing supporting evidence indicating activities between Sep 4, 2001 and May 31, 2002. For example **“The declarants further state that conception of the invention was followed by due diligence from the time of conception to a time just prior to effective date of the reference, up to actual reduction to practice of the invention and the filing of this application”** does not constitute an account of affirmative acts or acceptable excuses occurring between Sep 4, 2001 and May 31, 2002.

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent

owner had been diligent. Ex parte Hunter, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence.

In view of above discussion examiner maintains the rejection as follows:

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1,2, 4, 7, 8, 9-11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (US Publication NO 2003/0046542) in view of Gary et al. (US Patent NO 6,087,955).

**Regarding claim 1**

Chen teaches an apparatus comprising: a computer system motherboard; a security element coupled to said motherboard and enabling operation as a trusted computer platform; a first input device coupled to said motherboard and enabling input of data to said security element (paragraph [0034]). Chen does not explicitly teach a second input device selectively interposed between said first input device and said security element and enabling selective imposition of a security requirement for effective input of data to said security element from said



first input device. However, in an analogous art, Gray teaches a second input device selectively interposed between said first input device and said security element and enabling selective imposition of a security requirement for effective input of data to said security element from said first input device (column 4, lines 44-52). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus disclosed by Chen to include a second input device selectively interposed between said first input device and said security element and enabling selective imposition of a security requirement for effective input of data to said security element from said first input device. This would have been obvious because person having ordinary skill in the art at the time the invention was made would have been motivated to do so in order to enforce access control to one or more application programs running on the computer and furthermore to verify data entered through a keyboard with the data stored on a token such as a card, while isolating the entered data from the computer (column 2, lines 50-52).

**Regarding claim 9**

Chen teaches an apparatus comprising: a computer system motherboard; a security element mounted on said motherboard and enabling operation as a trusted computer platform; a first input device coupled to said motherboard and enabling input of data to said security element (paragraph [0034]). Chen does not explicitly teach a second input device coupled to said first input device and said

security element and enabling imposition of a security requirement for effective input of data to said security element from said first input device; and a switch interposed between said second input device and said first input device and said security element and enabling selective interposition of said second input device between said first input device and said security element. However, in an analogous art Gray teaches a second input device coupled to said first input device and said security element and enabling imposition of a security requirement for effective input of data to said security element from said first input device (column 4, lines 44-52); and a switch interposed between said second input device and said first input device and said security element and enabling selective interposition of said second input device between said first input device and said security element (column 6, lines 1-12). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus disclosed by Chen to include a second input device coupled to said first input device and said security element and enabling imposition of a security requirement for effective input of data to said security element from said first input device; and a switch interposed between said second input device and said first input device and said security element and enabling selective interposition of said second input device between said first input device and said security element. This would have been obvious because person having ordinary skill in the art at the time the invention was made would have been motivated to do so in order to enforce access control to one or more

application programs running on the computer and furthermore to verify data entered through a keyboard with the data stored on a token such as a card, while isolating the entered data from the computer (column 2, lines 50-52).

**Regarding claim 10**

Chen teaches a method comprising the steps of: coupling a keyboard to a security element in a trusted computing platform system to enable entry of data to the security element (paragraph [0034]). Chen does not explicitly teach selectively interposing between the keyboard and the security element a second input device imposing a security requirement for effective entry of data to the security element from the keyboard. However, in an analogous art, Gray teaches selectively interposing between the keyboard and the security element a second input device imposing a security requirement for effective entry of data to the security element from the keyboard (column 4, lines 44-52). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus disclosed by Chen to include selectively interposing between the keyboard and the security element a second input device imposing a security requirement for effective entry of data to the security element from the keyboard. This would have been obvious because person having ordinary skill in the art at the time the invention was made would have been motivated to do so in order to enforce access control to one or more application programs running on the computer and furthermore to verify data

entered through a keyboard with the data stored on a token such as a card, while isolating the entered data from the computer (column 2, lines 50-52).

**Regarding claims 2 and 4**

Chen and Gray teach all limitation of the claim as applied to claim 1 above. Chen furthermore teaches an apparatus, wherein said security element is mounted on said motherboard, and said first input device is a keyboard

**Regarding claims 7 and 8**

Chen and Gray teach all limitation of the claim as applied to claim 1 above. Gary furthermore teaches an apparatus, wherein said second input device is a card reader (column 4, line 67-column 5, line1) and a switch interposed between said second input device and said security element and selectively enabling interposition of second input device (column 6, lines 1-12).

**Regarding claim 11**

Chen and Gray teach all limitation of the claim as applied to claim 10 above. Gary furthermore teaches a method, wherein the step of selectively interposing a second input device comprises switching the state of connection of a second input device between being interposed and being excluded from interposition (column 6, lines 1-12).

**Regarding claim 12**

Chen and Gray teach all limitation of the claim as applied to claim 10 above. Gary furthermore teaches wherein the step of selectively interposing a second input device and imposing a security requirement comprises imposing a requirement for entry of a numeric sequence (column 6, lines 13-24).

**Regarding claim 14**

Chen and Gray teach all limitation of the claim as applied to claim 10 above. Gary furthermore teaches a method, wherein the step of selectively interposing a second input device and imposing a security requirement comprises imposing a requirement for submission of a physical key (column 5, lines 28-52).

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (US Publication NO 2003/0046542) in view of Gray et al. (US Patent NO 6,087,955) further in view of Harari et al. (US Patent NO 6,266,724).

**Regarding claim 3**

Chen and Gray teach all limitation of the claim as applied to claim 2 above. Chen furthermore teaches a motherboard with a security element socket ((paragraph [0034]) ("other standard component")). Chen and Gray do not explicitly teach an apparatus comprising a daughter card and security element

mounted on said daughter card. However, in an analogous art, Harari teaches an apparatus comprising daughter card (column 8, lines 24-36). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus disclosed by Chen and Gray to include a daughter card and security element mounted on said daughter card. This would have been obvious because person having ordinary skill in the art at the time the invention was made would have been motivated to do so in order to allow the functional components of a peripheral implemented on a PC card to be advantageously partitioned and furthermore to allow the user to add or decrease memory capacity (column 44, lines 16-18).

10. Claims 5, 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (US Publication NO 2003/0046542) in view of Gray et al. (US Patent NO 6,087,955) further in view of Gokcebay (US Patent NO 5,337,043).

#### **Regarding claims 5, 6 and 13**

Chen and Gray teach all limitation of the claim as applied to claims 1 and 10 above. Chen and Gray do not explicitly teach an apparatus/method, wherein said second input device is a keypad or biometric measuring device and the step of selectively interposing a second input device and imposing a security requirement comprises imposing a requirement for entry of a biometric measurement. However, in an analogous art, Gokcebay teaches an

apparatus/method, wherein said second input device is a keypad or biometric measuring device and the step of selectively interposing a second input device and imposing a security requirement comprises imposing a requirement for entry of a biometric measurement (column, lines 20-27). Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus/method disclosed by Chen and Gray to include an apparatus/method, wherein said second input device is a keypad or biometric measuring device and the step of selectively interposing a second input device and imposing a security requirement comprises imposing a requirement for entry of a biometric measurement. This would have been obvious because person having ordinary skill in the art at the time the invention was made would have been motivated to do so in order to provide an access control system which has a key reader for reading the encoded data on the key, and a reader of the attempted user's biometric feature such as a finger print (column 7, lines 15-19).

### **References Cited, Not Used**

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

1. U.S. Patent No. 6,138,239

This reference relates to a method for executing secure transactions of a computer system.

2. U.S. Patent No. 6,426,742

This reference relates to a method for controlling switch of input mode of keyboard instruction.

### **Conclusion**

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Ali Abyaneh AA  
Patent Examiner  
Art Unit 2137  
05-08-06

  
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SUPERVISORY PATENT EXAMINER